

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: WILLNER=9A

In re Application of:)	Conf. No.: 3654
)	
Itamar WILLNER et al)	Art Unit: 1635
)	
Appln. No.: 10/588,153)	Examiner: T. A. VIVEMORE
)	
I. A. Filed: 01/27/2005)	Washington, D.C.
371 (C): 03/02/2007)	
)	
For: CATALYTIC POLYNUCLEOTIDE)	January 14, 2009
AND ITS USE ...)	

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building, 401 Dulany Street
Alexandria, VA 22314

Sir:

The applicants are in receipt of the restriction requirement Office Action mailed December 12, 2008. A petition for one month's extension of time and the petition fee are attached hereto.

Restriction has been required among what the PTO deems as being five (5) separate inventions, on the basis of purported lack of unity of invention under PCT Rules 13.1 and 13.2. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group 1, directed to a method for

determination of an analyte in a test sample, and comprising at least claims 1-10 and 12-14, with traverse and without prejudice with respect to Groups 2 and 3.

Thus, applicants believe and respectfully submit that Groups 2 and 3 (presently claims 11, 15 and 18) relate to the same invention as the Group 1 claims, and therefore the requirement should be withdrawn with respect to Groups 2 and 3, whereby claims 11, 15 and 18 should be examined along with claims 1-10 and 12-14.

Claim 1 relates to a method for the determination of an analyte in a sample, and comprises 4 steps: (a) providing a catalytic polynucleotide; (b) contacting the catalytic polynucleotide with the sample so that the catalytic polynucleotide can bind to the analyte; (c) providing assay conditions such that the catalytic polynucleotide produces an optically detectable signal in the presence of the analyte; and (d) detecting the signal, thereby determining the presence of the analyte in the sample. Claim 10 (which the Examiner included in Group 1) defines the analyte as being immobilized to a solid surface. Claim 14 (which the Examiner included in Group 1) defines the analyte as a telomere repeat unit.

Claim 11 claims the method of claim 1 wherein the analyte is a member of a complex forming group, and the

catalytic polynucleotide is bound to another member of the complex forming group. This method is included within the scope of the method of claim 1, and the steps of the method of claim 11 are not in conflict with the steps of the method of claim 1, i.e. they are not mutually exclusive. Groups 1 and 2 share the same technical feature, which is determination of an analyte. The fact that the analyte is one member of a complex forming group does not make it any less an analyte. Applicants therefore respectfully request the Examiner to withdraw the restriction requirement with respect to Groups 1 and 2.

Claims 15 and 18 call for the method according to claim 1 for the detection of telomerase or telomerase activity in a sample. Telomerase is an example of an analyte, and is included within the scope of an analyte. The methods of claims 15 and 18 include an additional step of providing a primer for telomerase activity immobilized on a solid surface, but this step is neither in conflict with the steps of the method of claim 1 nor in overlap with them (as stated by the Examiner). Claims 15 and 18 are simply more detailed than claim 1, i.e. add additional subject matter, but are not mutually exclusive. Groups 1 and 3 share the same technical feature, which is determination of an analyte. The fact that the analyte is a telomerase does not make it any less an

analyte. Applicants therefore respectfully request the Examiner to withdraw the restriction requirement with respect to Groups 1 and 3.

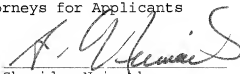
Applicants also respectfully note that claim 1 is a generic claim. If claim 1 is patentable, then the PTO would not have authority for not allowing any claims which depend from claim 1. Accordingly, to the extent that the requirement is any more than a requirement for election of species, applicants respectfully submit that it is in conflict with *In re Weber et al*, 198 USPQ 328, 331 (CCPA 1978). In *Weber* the examiner had held the generic claim to be "improper", constituting a "misjoinder under 35 USC 121." After affirmation by the Board, the Court reversed.

Withdrawal of the requirement at least with respect to presently non-elected Groups 2 and 3, and examination on the merits of all of claims 1-15 and 18 at least, are therefore respectfully requested.

Respectfully submitted,

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